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LAI, MICHAEL C				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/686,429

Applicant(s)

DANIELL, W. TODD

Examiner

MICHAEL C. LAI

Art Unit

2457

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 4-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/5508)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This office action is responsive to communication filed on 11/2/2009.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/2/2009 has been entered.

Response to Amendment

The examiner has acknowledged the amended claims 1, 2, 10, 13, cancelled claim 3, and new claim 21. Claims 1, 2, 4-21 are pending.

Applicant has not pointed out where the limitations of the amended claims 1, 10, and 13 are supported in the specification. (See MPEP chapter 2163.03 section (I.) and chapter 2163.04 section (I.) and chapter 2163.06) Applicant is requested to provide support for the amended claims mentioned above.

Response to Arguments

Applicant's arguments filed 11/2/2009 with respect to the 103 rejections have been considered but they are not persuasive.

In the remarks, the applicant argues in substance that: Friskel fails to overcome the deficiencies of Hickey and Heyen. More specifically, Friskel discloses a "sender status column 308 to indicate the on-line status of each sender of an e-mail using status

indicators 310" (column 5, line 9). However, this deals with an indicator that is provided to an email recipient. Consequently, this is completely different than a "communication system...", wherein the system is configured to provide an interface that includes a single user-selectable option for a user to select whether predetermined presence data for both the email application and the instant messaging application is sent to email recipients" as recited in claim 1.

In response to the arguments, Friskel discloses a real-time messaging application that is linked with an email application, the real-time messaging application being associated with a common account as the email application, wherein the system is configured to provide an interface that includes a single option to determine presence data for both the email application and the real-time messaging application [see Fig. 3 and col. 5, lines 4-49]. The presence data including "on-line" (sender is logged into the messaging system), "off-line" (sender is not logged into the messaging system), "accepting chat" (sender welcomes real-time messaging initiation by the client user), "do not disturb" (sender does not want to engage in real-time messaging), and "no information available for this sender" (sender is not a member of the messaging system). Friskel's teaching is from recipients' point of view. The amended limitation is from senders' point of view. The amended limitation is a mere reversal of Friskel's teaching. In order to support Friskel's feature, it involves only routine skill in the art to have a "communication system...", wherein the system is configured to provide an interface that includes a single user-selectable option for a user to select whether

predetermined presence data for both the email application and the instant messaging application is sent to email recipients" as recited in claim 1.

Thus, in view of such, the rejection is sustained as follows:

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 10, and 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amended limitation "wherein the system is configured to provide an interface that includes a single user-selectable option for a user to select whether predetermined presence data for both the email application and the instant messaging application is sent to email recipients" is not described in the specification. As such, the limitation is considered as a new subject matter.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 4-7, 9-18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hickey et al. (US 2002/0087646 A1, hereinafter Hickey), in view of Heyen et al. (US 5,093,918, hereinafter Heyen), and further in view of Friskel (US 6,839,737 B1, hereinafter Friskel).

Regarding claim 1, Hickey teaches a communication system comprising:

a client-side group email folder accessible by each user in a predefined group of users (FIG. 3 and para. 0037);

a group email message in the client-side group email folder that is provided by an email application, the group email message having an indicator configured to indicate whether the corresponding group members have acted upon the group email message, wherein the group email message is stored in a common database such that users of the group have access to the group email message via the database (FIG. 3 and para. 0010, 0021, 0043, 0057).

Hickey discloses substantially all the limitations including the idea that users will each typically have an individual mailbox as well as access to group electronic mailbox. Users can electronically communicate with one another by exchanging e-mail messages over the network through individual e-mail mailboxes and group electronic mailbox 25 (see FIG. 2 and para. 0036). However, Hickey fails to disclose specifically that each user in the predefined group has an indicator (instead of one indicator for the group), and the option to view at least one user-specific email, the user-specific email being different than the group email message. Heyen discloses a method for providing a user dependent status indication for shared electronic mail

objects within a distributed computing system. Heyen further discloses an attribute list that is associated with each electronic mail object which may contain multiple sets of attributes, each set associated with a group of recipients, a subgroup of recipients or an individual end user having access to that electronic mail object. Thereafter, the activities of each end user are utilized to modify each attribute list associated with that end user. An end user may then periodically determine and display the status of an individual mail object with regard to the entire group of recipients, a subgroup of recipients or an individual end user (see abstract and column 2 line 61 through column 3 line 58). It would be obvious to one skilled in the art at the time of the invention was made to incorporate Heyen's teaching into Hickey's method for the purpose of supporting a user's group and private email status indications by defining three different view profiles (public, group, and private), thereby providing user-specific email being different than the group email message and a user dependent status indication suitable for utilization with shared electronic mail objects (i.e., group email folder) (see column 1, lines 41-44).

Hickey and Heyen disclose the claimed invention except for an instant messaging application that is linked with the email application, the instant messaging application being associated with a common account as the email application, wherein the system is configured to provide an interface that includes a single user-selectable option for a user to select whether predetermined presence data for both the email application and the instant messaging application is sent to email recipients. However, Friskel discloses a real-time messaging application that is

linked with an email application, the real-time messaging application being associated with a common account as the email application, wherein the system is configured to provide an interface that includes a single option to determine presence data for both the email application and the real-time messaging application [see Fig. 3 and col. 5, lines 4-49]. The presence data including "on-line" (sender is logged into the messaging system), "off-line" (sender is not logged into the messaging system), "accepting chat" (sender welcomes real-time messaging initiation by the client user), "do not disturb" (sender does not want to engage in real-time messaging), and "no information available for this sender" (sender is not a member of the messaging system). Friskel's teaching is from recipients' point of view. The amended limitation is from senders' point of view. The amended limitation is a mere reversal of Friskel's teaching. It would have been obvious to a person with ordinary skill in the art at the time the invention was made to incorporate Friskel's teaching into Hickey's and Heyen's system for the purpose of integrating email and instant messaging applications by configuring the system to provide an interface that includes a single user-selectable option for a user to select whether predetermined presence data for both the email application and the instant messaging application is sent to email recipients, thereby providing an enhanced and user friendly email/Instant Messaging system.

Regarding claim 2, Hickey further teaches wherein each indicator comprises a first setting, the first setting indicating that the group email message has not been

acted upon by the corresponding user (para. 0079, New), and wherein each indicator further comprises a second setting, the second setting indicating that the group email message has been acted upon by the corresponding user (para. 0043, acted upon information.).

Regarding claim 4, Hickey further teaches wherein each indicator is further indicative of whether the corresponding user has selected the group email message (para. 0063, first column 143A).

Regarding claim 5, Hickey further teaches wherein each indicator is further indicative of whether the corresponding user has opened the group email message (para. 0079, Read, Answered, Moved, etc.).

Regarding claim 6, Hickey further teaches the system of claim 1, further comprising a second indicator indicative of whether the corresponding user has deleted the group email message (para. 0078, lines 12-20 and para. 0079, lines 1-3).

Regarding claim 7, Hickey teaches the system of claim 1, further comprising means for indicating whether a user has deleted the group email message (para. 0078, lines 12-20 and para. 0079, lines 1-3).

Regarding claim 9, Hickey further teaches wherein each user represents a unique individual (para. 0051, lines 6-9).

Regarding claim 10, Hickey teaches a communication method comprising:

providing indicators in a group email message, the group email message being located in an inbox, each indicator corresponding to one of the users in a predefined group of users, each indicator having a setting, each indicator configured to indicate whether the corresponding user has acted upon the group email message (para. 0060, step 138 and para. 0061, step 140); and

changing the setting of one indicator in response to the email message being acted upon by its corresponding user (para. 0064), wherein the group email message is stored in a common database such that users of the group have access to the group email message via the database (FIG. 3 and para. 0010, 0021, 0043, 0057).

Hickey discloses substantially all the limitations including the idea that users will each typically have an individual mailbox as well as access to group electronic mailbox. Users can electronically communicate with one another by exchanging e-mail messages over the network through individual e-mail mailboxes and group electronic mailbox 25 (see FIG. 2 and para. 0036). However, Hickey fails to disclose specifically that each user in the predefined group has an indicator (instead of one indicator for the group), and the option to view at least one user-specific email, the user-specific email being different than the group email message. Heyen discloses a method for providing a user dependent status indication for shared electronic mail objects within a distributed computing system. Heyen further discloses an attribute list that is associated with each electronic mail object which may contain multiple sets of attributes, each set associated with a group of recipients, a subgroup of

recipients or an individual end user having access to that electronic mail object. Thereafter, the activities of each end user are utilized to modify each attribute list associated with that end user. An end user may then periodically determine and display the status of an individual mail object with regard to the entire group of recipients, a subgroup of recipients or an individual end user (see abstract and column 2 line 61 through column 3 line 58). It would be obvious to one skilled in the art at the time of the invention was made to incorporate Heyen's teaching into Hickey's method for the purpose of supporting a user's group and private email status indications by defining three different view profiles (public, group, and private), thereby providing user-specific email being different than the group email message and a user dependent status indication suitable for utilization with shared electronic mail objects (i.e., group email folder) (see column 1, lines 41-44).

Hickey and Heyen disclose the claimed invention except for providing, by an email application, an interface for providing the group email message and an option to view at least one user-specific email, the user-specific email being different than the group email message, the interface including an instant messaging interface for a common account as the email application, wherein providing an interface includes providing a single user-selectable option for a user to select whether predetermined presence data for both the email application and the instant messaging application is sent to email recipients. However, Friskel discloses a real-time messaging application that is linked with an email application, the real-time messaging application being associated with a common account as the email application,

wherein the system is configured to provide an interface that includes a single option to determine presence data for both the email application and the real-time messaging application [see Fig. 3 and col. 5, lines 4-49]. The presence data including "on-line" (sender is logged into the messaging system), "off-line" (sender is not logged into the messaging system), "accepting chat" (sender welcomes real-time messaging initiation by the client user), "do not disturb" (sender does not want to engage in real-time messaging), and "no information available for this sender" (sender is not a member of the messaging system). Friskel's teaching is from recipients' point of view. The amended limitation is from senders' point of view. The amended limitation is a mere reversal of Friskel's teaching. It would have been obvious to a person with ordinary skill in the art at the time the invention was made to incorporate Friskel's teaching into Hickey's and Heyen's system for the purpose of integrating email and instant messaging applications by providing a single user-selectable option for a user to select whether predetermined presence data for both the email application and the instant messaging application is sent to email recipients, thereby providing an enhanced and user friendly email/Instant Messaging system.

Regarding claim 11, Hickey further teaches the method of claim 10, wherein providing indicators comprises providing read indicators, each read indicator corresponding to one user in a predefined group of users, each read indicator being

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configured to indicate whether its corresponding user has read the email message
(para. 0079, Read).

Regarding claim 12, Hickey further teaches the method of claim 10, wherein providing indicators comprises providing delete indicators, each delete indicator corresponding to one user in a predefined group of users, each delete indicator being configured to indicate whether its corresponding user has deleted the email message. each delete indicator being configured to indicate whether its corresponding user has deleted the email message (para. 0078, lines 12-20 and para. 0079, lines 1-3).

Claim 13 is of the same scope as claim 10. It is rejected for the same reason as for claim 10.

Claim 14 is of the same scope as claim 11. It is rejected for the same reason as for claim 11.

Claim 15 is of the same scope as claim 12. It is rejected for the same reason as for claim 12.

Claim 16 is of the same scope as claim 4. It is rejected for the same reason as for claim 4.

Claim 17 is of the same scope as claim 5. It is rejected for the same reason as for claim 5.

Claim 18 is of the same scope as claim 7. It is rejected for the same reason as for claim 7.

Claim 20 is of the same scope as claim 12. It is rejected for the same reason as for claim 12.

5. Claims 8 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hickey, Heyen, and Friskel, and further in view of Stark et al. (US 2003/0233420 A1, hereinafter Stark).

Regarding claim 8, Hickey, Heyen, and Friskel teach the system of claim 1, but fail to disclose wherein the indicator is an extensible markup language (XML) tag corresponding to a user in the predefined group. However, Stark shows embedded XML tags that describe certain attributes of messages [Page 3, Para. 0035]. It would therefore be obvious to one of ordinary skill in the art at the time of the invention to incorporate the teaching of Stark into Hickey's, Heyen's, and Friskel's system to use XML tag for the indicator corresponding to a user in the predefined group. The motivation would be taking the advantage of the widely accepted language of e-commerce (XML).

Claim 19 is of the same scope as claim 8. It is rejected for the same reason as for claim 8.

6. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hickey, Heyen, and Friskel, and further in view of Roskind et al. (US 7,124,123 B1, hereinafter Roskind).

Regarding claim 21, Hickey, Heyen, and Friskel teach the system of claim 1, but fail to disclose wherein the single user selectable option includes an option to activate an auto away timer. However, Roskind discloses a user's away status and a response component 320 that determines the appropriate response (420) by accessing the user's recent away history to determine that the user will likely be

back in some time [see abstract, Fig. 3, and col. 11, lines 32-39]. It would therefore be obvious to one of ordinary skill in the art at the time of the invention to incorporate the teaching of Roskind into Hickey's, Heyen's, and Friskel's system to activate an auto away timer. The motivation would be alerting the recipients that the user is away [see col. 1, lines 36-43].

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL C. LAI whose telephone number is (571)270-3236. The examiner can normally be reached on M-F 8:30 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael C. Lai
04DEC2009

/YVES DALENCOURT/
Primary Examiner, Art Unit 2457